

REMARKS

## 1) Incomplete Office Action – New Action Requested

Applicant respectfully asserts that the Office Action mailed October 20, 2003 is incomplete and effectively insufficient for a number of reasons, thus making it impossible for the Applicant to comprehend the legal and factual basis for the rejections. As such, it is impossible for Applicant to fully address the rejections of record because to do so would require guesswork and speculation, which is beyond the scope of appropriate patent prosecution. Applicant respectfully requests the issuance of a new, complete Office Action and the withdrawal of the finality of the October 20<sup>th</sup> Office Action if the Examiner chooses to maintain the rejections of record after considering the remarks presented herein.

## A) Grounds of rejection unclear

The Examiner previously rejected certain claims (e.g., claim 33) under 35 USC 103(a) over Albert in view of Brown. Presently, the same claims are now rejected over Albert in view of Sato. Albert remains insufficient for the same reasons previously acknowledged by the Examiner and Sato does not address these issues. Thus, it is unclear which references are actually relied on by the Examiner. The explicitly recited combination of Albert and Sato not only fails; such failure was previously acknowledged by the Examiner by reliance on Brown. Thus, the rejection does not provide a *prima facie* case of obviousness and the Examiner is requested to clarify which references are relied for each element of the claims for any subsequent rejection.

## B) Basis of rejection cannot be determined

With respect to claims 33, 35, 39-44, 47 and 68, the Examiner is asserting that the combination of Albert and Sato provides a *prima facie* case of obviousness. As the Examiner is well aware, the burden of establishing a *prima facie* case of obviousness lies with the Examiner. To do so, the Examiner must indicate what each reference teaches, what it fails to teach, how the other reference provide the missing elements, how they are properly combinable and present a legally sufficient motivation to combine the references.

In the present case, the Examiner appears to be summarily addressing certain amended subject matter. The Examiner quotes extensively from Albert. At the end of the first paragraph of page 3, the Examiner transitions from this quotation to "[h]owever, the collective teachings of Albert and Sato disclose such a feature." What feature? What is acknowledged as missing from Albert? What does Sato provide? How is it appropriately combinable? How do the references support such a conclusion? The quoted section of Albert is of only minor relevance and sheds no light. Applicant can only assume that the Examiner intended to present more information that was inadvertently deleted from the final document; however, the rejection as presented is incomplete and cannot be properly responded to, understood, or evaluated.

The subsequent paragraph is similarly incomprehensible and simply makes a conclusory statement having seemingly little relevance to the issues at question. Finally, the third paragraph references "claim 1" and the previous office action. Claim 1 is obviously not at issue here and such a statement only serves to further confuse the situation.

The Examiner is respectfully requested to issue a full, accurate, and complete Office Action, if such grounds of rejection are maintained. The finality of the present Office Action must be withdrawn.

2) Patentability of the pending claims

A) As the Office Action does not present a full, complete and discernable rejection for many of the claims, Applicant cannot properly analyze, let alone respond to the specific outstanding rejections. As such, Applicant will provide a basic analysis of why the pending claims are allowable over the art cited and respond to the specific rejections to the extent possible.

B) The Examiner has responded to the arguments put forth by Applicant in the previous response. Applicant respectfully suggests that those arguments were not fully considered or rebutted by the Examiner.

First, the Examiner asserts that Sato discloses the various fee generation/collection mechanisms presented in various claims. This is simply incorrect. Sato disclose little more than the practice of medicine via videoconferencing. The

doctor and patient meet "face to face", so to speak, and are fully interactive in a communications sense. Data, e.g., blood pressure information, may be transmitted via the videophone to the doctor currently speaking with the patient. Normal electronic patient data records are maintained with patient information (name, address, etc.), doctor diagnostic information, X-rays, and the like. After conducting a patient examination via the videophone, the doctor bills the patient for his services. The bill may be sent electronically and paid through a bank via electronic means (account debiting).

Conversely, the present invention, in one embodiment, is a system that collects physiologic medical data from patient with medical devices, such as an implantable pacemaker/defibrillator. This information is stored in memory and then, upon request, selectively accessed by an interested party, such as a doctor. The fee at issue is for the information. For example, claim 1 includes "monitoring data packages to determine revenue for the service." The mere fact that Sato discloses fees for providing medical evaluations (i.e., doctor evaluations) does not teach or suggest this element. Aside from quoting at length from the reference, the Examiner has provided no explanation as to how a doctor billing for a consultation applies to the present claims where fees are charged for data. As such, the rejection is improper and must be withdrawn.

The Examiner then asserts that the references teach the "enabling of a database network site to communicate with at least one web-enabled web-site to receive web-site originated signals requesting access to the database of stored physiological data." In support of this conclusion, extensive passages of Albert are quoted at length. Applicant greatly appreciates the Examiner pointing out exactly what portions of the reference are being relied on; however, the Examiner has generally quoted the text, asserted it teaches the claimed limitations without further analysis or explanation and concluded. Applicant respectfully requests that if such rejections are maintained that the Examiner explain how the reference fully meet the claim limitations and the Examiner's interpretations, as the quoted passages on their face clearly do not lead to such a conclusion.

In particular, Albert teaches a system whereby a user can remotely send data to a doctor. The patient accesses a web-site to obtain software to accomplish this task.

Once the software is obtained, the patient uses this software to transmit the data through the Internet either a) directly to the doctor's computer or b) to a clinic computer that then forwards the information to the doctor (e.g., via a pager). There is no database that is selectively accessed by "web enabled web sites". Again, the mere fact that the reference allows software to be downloaded by the patient through a web-site does not teach the claimed element, wherein data is requested via a web site. Any electronic data, in both references, is simply sent directly to the doctor.

The Office Action then groups three separate arguments related to obviousness and manages to summarily reject them all without actually addressing the merits of any argument. First, the combination of Albert and Sato is addressed. Albert teaches a method of downloading software so that data can be sent directly to a doctor. Sato teaches the practice of medicine via videophone. Thus, if combined the result is the addition of this form of data transfer directly to a doctor while practicing medicine via a videophone. The two are quite combinable, but the point is that the resultant combination is not the presently claimed invention. The Examiner is correct in asserting that the two references may be relied on for what they would teach one of ordinary skill in the art; however, that is a limitation and not a license to assert that the combined teachings may be then further modified to reach the claims based on no more than the Examiner's desire to forge a rejection and hindsight. The combination of references must stand on its own to fully teach each and every element of the fully analyzed and properly construed claims in the full context of the claim. The combination of Albert and Sato falls without question in this regard.

Thus, the Examiner has failed to provide any valid motivation for making such a combination, then further drastically modifying the combination to change it into the presently claimed invention. As such, this rejection is baseless for two reasons. The first is again, the references must teach the elements; the Examiner may not simply conjure them into existence. The second is that there must be a motivation, aside from the formation of a rejection to make such a combination.

In the present case, why would one of ordinary skill in the art combine Albert and Sato, which both involve the direct transfer of data from a patient to a doctor to add a middle party, then make the doctor request the data, and make the doctor pay for the

data, as expressed in certain embodiments of the present invention (none of which is disclosed, taught, suggested or implied)? The "logic and sound scientific reasoning" referred to in the Office Action would clearly indicate that no such motivation exists. The present invention is in a different context and serves different goals and purposes than these references. The Examiner is most clearly relying on improper hindsight to try to adapt these references to the present claims.

The Office Action concludes by asserting that one cannot establish non-obviousness by attacking the combined reference individually. While this is certainly true, it is irrelevant. The question at issue is whether the references when so combined actually teach the claimed invention; here, they do not. Albert teaches obtaining software to send data to a doctor directly; Sato teaches the practice of medicine via videophone. When combined, the result still fails to teach the pending claims.

Thus, neither alone or in combination do the references teach storing patient data that can be retrieved from a web-site (in both Albert and Sato information is sent directly to the health care system); allocating fees from/for this data (Sato has traditional billing for doctor services); providing for a disease management organization (neither reference addresses this concept); or automatically identifying a patient from e.g., implant data, wherein some or all of these elements are presented in various forms within certain claims. With respect to the last element, again both Sato and Albert are a direct link between the patient and a doctor so there is no basis for modifying either to include such automated identification or such automated identification based on an implantable device. These issues do not form the sole basis for distinction between the various claims and the cited references, but are merely exemplary.

Finally, Krichen et al. is not a proper reference. That is, under 35 USC 103(c), US Patent 6,250,309 is only valid as a reference under 35 USC 102(e), based on the present priority claim, and at the time of invention was subject to an obligation of assignment to Medtronic, Inc. the assignee of the present application.

### 3) Conclusion

The claims of the present application are in condition for allowance and notice of the same is respectfully requested. Should the Examiner wish to maintain the current

JAN. 5. 2004 11:31AM

MEDTRONIC LAW DEPT

NO. 8660 P. 9/9

rejection, Applicant requests the withdrawal of finality of the present Office Action and requests that full and complete grounds for rejection, explanations and supporting statements be provided in any subsequent Office Action.

Should any issues remain outstanding, the Examiner is respectfully requested to telephone the undersigned to expedite prosecution.

Respectfully submitted,

Date: 1/5/04

  
Daniel G. Chapik  
Attorney Reg. 43,424  
Telephone: (763) 514-3066  
Customer No. 27581